

-- REMARKS --

The present amendment replies to an Office Action dated October 17, 2007. Claims 1-10 are pending in the present application. Claims 1, 6, 9, and 10 have been amended and claims 11-19 added herein. In the Office Action, the Examiner rejected claims 1-10 on various grounds. The Applicants respond to each ground of rejection as subsequently recited herein and requests reconsideration of the present application.

Specification

The Examiner suggested an Arrangement of the Specification including section headings. The Applicants respectfully decline to add the headings, as they are only suggested and not required. *See* MPEP §608.01(a).

Claim objection

The Examiner objected to claim 10 for the use of “beamer,” asserting that the term is not a recognized term in the art in English. Claim 10 has been amended herein to recite a “beamer multimedia projector” to facilitate prosecution and not to avoid any cited reference. Withdrawal of the objection to claim 10 is respectfully requested.

35 U.S.C. §112 Rejections

The Examiner rejected claims 6, 9, and 10 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 has been amended herein to recite that the porosity of the finished ceramic wall of the discharge vessel is smaller than 0.01 % to facilitate prosecution and not to avoid any cited reference.

Claim 9 and 10 have been amended to depend from claim 6 to facilitate prosecution and not to avoid any cited reference.

Withdrawal of the rejection of claims 6, 9, and 10 under 35 U.S.C. §112, second paragraph, as is respectfully requested.

35 U.S.C. §102 Rejections

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102 rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. The Applicants respectfully assert that the cited references fail to do so.

A. Claims 1-3 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,456,005 to Panchula, *et al.* (the *Panchula* patent).

The Applicants respectfully assert that the *Panchula* patent fails to disclose, teach, or suggest a process of manufacturing a high-intensity discharge lamp including in order to improve light transmission of the discharge vessel, said process comprises the step of placing the discharge vessel in contact with a suspension of inorganic particles and allowing the suspension to enter pores in said wall, thus completely coating the surface of said wall, as recited in independent claim 1. At most, the *Panchula* patent discloses a metal based coating applied to the surface of the arc tube, preferably as a strip or a ring covering not more than about 3% of the surface area of the arc tube. *See* Figures 1, 2; column 3, line 66, through column 4, line 6. The metal based coating functions solely as a starting aid, and so fails to disclose completely coating the surface of said wall or to address the light scattering problem and improved light transmission of the present invention as claimed.

Claims 2 and 3 depend directly from independent claim 1 and so include all the elements and limitations of independent claim 1. The Applicants therefore respectfully submit that dependent claims 2 and 3 are allowable over the *Panchula* patent for at least the same reasons as set forth above for independent claim 1.

Withdrawal of the rejection of claims 1-3 under 35 U.S.C. §102(b) as being anticipated by the *Panchula* patent is respectfully requested.

35 U.S.C. §103 Rejections

Obviousness is a question of law, based on the factual inquiries of 1) determining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP 2143.03. The Applicants respectfully assert that the cited references fail to teach or suggest all the claim limitations.

B. Claims 4 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of U.S. Patent No. 5,039,550 to Malghan, *et al.* (the *Malghan* patent).

The Applicants respectfully assert that the *Panchula* patent and the *Malghan* patent, alone or in combination, fail to disclose, teach or suggest each and every element of the Applicants' invention as claimed, as required to maintain a rejection under 35 U.S.C. §103(a). As discussed in Section A above, the Applicants assert that the *Panchula* patent fails to disclose, teach, or suggest a process of manufacturing a high-intensity discharge lamp including in order to improve light transmission of the discharge vessel, said process comprises the step of placing the discharge vessel in contact with a suspension of inorganic particles and allowing the suspension to enter pores in said wall, thus completely coating the surface of said wall, as recited in independent claim 1. The *Malghan* patent also fails to disclose these elements. Claims 4 and 5 depend indirectly from independent claim 1 and so include all the elements and limitations of

independent claim 1. The Applicants therefore respectfully submit that dependent claims 4 and 5 are allowable over the *Panchula* patent in view of the *Malghan* patent for at least the same reasons as set forth above for their respective independent claims.

Withdrawal of the rejection of claims 4 and 5 under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of the *Malghan* patent is respectfully requested.

C. Claims 6 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of U.S. Patent Publication No. 2002/0171363 A1 to Scott, *et al.* (the *Scott* publication).

The Applicants respectfully assert that the *Panchula* patent and the *Scott* publication, alone or in combination, fail to disclose, teach, or suggest a high-intensity discharge lamp including a coating of inorganic particles that completely covers and is made an integral fused part of the ceramic wall of the discharge vessel, as recited in independent claim 6. At most, the *Panchula* patent discloses a metal based coating applied to the surface of the arc tube, preferably as a strip or a ring covering not more than about 3% of the surface area of the arc tube. *See* Figures 1, 2; column 3, line 66, through column 4, line 6. The metal based coating functions solely as a starting aid, and so fails to address the light scattering problem and improved light transmission of the present invention. The *Scott* publication also fails to disclose these elements.

In addition, the *Scott* publication fails to disclose the integral fused part having a pore-filling effect such that the porosity of the finished ceramic wall of the discharge vessel is smaller than 0.01 %, as recited in independent claim 6. At most, the *Scott* publication discloses that the arc tube has a few percent of "closed" porosity. *See* paragraph [0025]. The *Scott* publication fails to disclose any numerical values for porosity, and so fails to disclose the value of porosity as recited in independent claim 6.

Claim 7 depends directly from independent claim 6 and so includes all the elements and limitations of independent claim 6. The Applicants therefore respectfully submit that dependent claim 7 is allowable over the *Panchula* patent and the *Scott* publication for at least the same reasons as set forth above for independent claim 6.

Regarding claim 7, the *Scott* publication fails to disclose any numerical values for total transmission, total forward transmission, or real in-line transmission, and so fails to disclose the values of transmission, total forward transmission, and real in-line transmission as recited in dependent claim 7.

Withdrawal of the rejection of claims 6 and 7 under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of the *Scott* publication is respectfully requested..

D. Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of U.S. Patent Publication No. 2002/0008851 A1 to Moench, *et al.* (the *Moench* publication).

The Applicants respectfully assert that the *Panchula* patent and the *Moench* publication, alone or in combination, fail to disclose, teach or suggest each and every element of the Applicants' invention as claimed, as required to maintain a rejection under 35 U.S.C. §103(a). As discussed in Section C above, the Applicants assert that the *Panchula* patent fails to disclose, teach, or suggest a high-intensity discharge lamp including a coating of inorganic particles that completely covers and is made an integral fused part of the ceramic wall of the discharge vessel, as recited in independent claim 6. The *Moench* publication also fails to disclose these elements.

Claim 8 depends directly from independent claim 6 and so includes all the elements and limitations of independent claim 6. The Applicants therefore respectfully submit that dependent claim 8 is allowable over the *Panchula* patent and the *Moench* publication for at least the same reasons as set forth above for independent claim 6.

Withdrawal of the rejection of claim 8 under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of the *Moench* publication is respectfully requested.

E. Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of U.S. Patent Publication No. 2001/0046138 A1 to Oyama, *et al.* (the *Oyama* publication).

The Applicants respectfully assert that the *Panchula* patent and the *Oyama* publication, alone or in combination, fail to disclose, teach or suggest each and every element of the Applicants' invention as claimed, as required to maintain a rejection under 35 U.S.C. §103(a). As discussed in Section C above, the Applicants assert that the *Panchula* patent fails to disclose, teach, or suggest a high-intensity discharge lamp including a coating of inorganic particles that completely covers and is made an integral fused part of the ceramic wall of the discharge vessel, as recited in independent claim 6. The *Oyama* publication also fails to disclose these elements.

Claim 9 depends directly from independent claim 6 and so includes all the elements and limitations of independent claim 6. The Applicants therefore respectfully submit that dependent claim 9 is allowable over the *Panchula* patent and the *Oyama* publication for at least the same reasons as set forth above for independent claim 6.

Withdrawal of the rejection of claim 9 under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of the *Oyama* publication is respectfully requested.

F. Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of U.S. Patent Publication No. 2001/0003411 A1 to Honda, *et al.* (the *Honda* publication).

The Applicants respectfully assert that the *Panchula* patent and the *Honda* publication, alone or in combination, fail to disclose, teach or suggest each and every element of the Applicants' invention as claimed, as required to maintain a rejection under 35 U.S.C. §103(a). As discussed in Section C above, the Applicants assert that the *Panchula* patent fails to disclose, teach, or suggest a high-intensity discharge lamp including a coating of inorganic particles that completely covers and is made an integral fused part of the ceramic wall of the discharge vessel, as recited in independent claim 6. The *Honda* publication also fails to disclose these elements.

Claim 10 depends directly from independent claim 6 and so includes all the elements and limitations of independent claim 6. The Applicants therefore respectfully submit that dependent claim 10 is allowable over the *Panchula* patent and the *Honda* publication for at least the same reasons as set forth above for independent claim 6.

Regarding claim 10, the *Honda* publication fails to disclose a beamer multimedia projector.

Withdrawal of the rejection of claim 10 under 35 U.S.C. §103(a) as being unpatentable over the *Panchula* patent in view of the *Honda* publication is respectfully requested.

New Claims

Claims 11-19 have been added to more particularly point out and distinctly claim the Applicants' invention. Claims 11-14 and claim 15 depend directly or indirectly on independent claim 1 and claim 6, respectively, and so are allowable for at least the reasons as their respective independent claims. No new matter has been added with the inclusion of claims 11-19, which is supported in the specification at least on pages 2-5.

Allowance of claims 11-19 is respectfully requested.

SUMMARY

Reconsideration of the rejection of claims 1-10 and consideration of claims 10-19 is requested. The Applicants respectfully submit that claims 1-19 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,
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